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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,761	10/31/2001	Thomas C. Amon	EVU-02-PUSA	5829

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COHEN SAKAGUCHI & ENGLISH LLP
2040 MAIN STREET, 9TH FLOOR
IRVINE, CA 92614

EXAMINER

EDELMAN, BRADLEY E

ART UNIT PAPER NUMBER

2153

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/001,761	Applicant(s) AMON ET AL.	
	Examiner Bradley Edelman	Art Unit 2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to Applicant's remarks made in a response filed on July 19, 2004. In a telephone interview with the Examiner, Applicant pointed out that the affidavits filed on June 16, 2003 were not considered in Examiner's previous Office action. Examiner agrees, and will discuss the affidavits below. Because of Examiner's oversight, this Office action is non-final. Claims 1-11 are presented for examination. Note that this application is a continuation of application no. 08/912,991, which has been abandoned.

Response to Amendment

1. The Affidavits filed on June 19, 2003 under 37 CFR 1.131 have been considered but are ineffective to overcome the Shi reference (U.S. Patent No. 5,875,296, filed January 28, 1997).

The Affidavits contain an insufficient showing of facts to establish reduction to practice prior to the effective date of the Shi reference. According to 37 CFR 1.131(b), "the showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference..." wherein "original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained." Applicant has failed to comply with this requirement, for the following reasons:

- a. The language of the Affidavit filed by Thomas C. Amon ("Applicant") does not clearly state that the invention was actually reduced to practice prior to the Shi

reference. For instance, paragraph 7 of the Affidavit describes that “the demonstration *would* cause an HTML advertisement to appear...” and “the advertisement *would* appear...” (emphasis added). This does not clearly show that the steps discussed were actually demonstrated to Mr. Haraldsvik, and also does not clearly show that the actual computer program of the claimed invention was run. In addition, the paragraph later states “further, I was able to demonstrate if a user submitted a second request....” Again, this does not clearly prove that the actual computer program embodying the claimed invention was run – it merely describes that a demonstration was made. Such a demonstration could consist of a simple explanation of how the invention is intended to work.

b. The Affidavit filed by Ronny Haraldsvik does not clear up the ambiguous statements made in Applicant’s affidavit, and also does not clearly show reduction to practice of the claimed invention. For instance, the same language of “the demonstration *would* cause,” and “the advertisement *would* appear,” is used. See paragraph 6. Paragraph 6 also states, “further, *it was explained* that if a request was submitted for the same HTML page....” This language suggests that no physical demonstration of that aspect of the invention was actually made, but instead, it was only explained to Mr. Haraldsvik.

c. Applicant’s submission contains no original exhibits of drawings or records that establish reduction to practice of the claimed invention.

i. In addition to the two affidavits, Applicant has submitted a reciprocal nondisclosure agreement signed by Mr. Haraldsvik on September 5, 1996. Aside from

the fact that this reciprocal agreement does not clearly name Applicant as a party and is not signed by him, the reciprocal nondisclosure agreement makes no reference to the actual invention, and thus contains no evidence in itself regarding reduction to practice.

ii. Furthermore, the affidavits describe certain documents, such as a magazine with notes, and a computer program, but no such evidence has been supplied. For instance, no software code or pseudo-code has been supplied with regard to the claimed invention. Applicant's affidavit states that Applicant does not have a copy of the original code "because the code has changed many times since then." Although 37 CFR 1.131(b) provides that original exhibits or records needn't be supplied if "their absence [is] satisfactorily explained," the statement that the code has changed over time is not a satisfactory explanation of a failure to supply it. Applicant should be able to submit a copy of the code, pseudo-code, or related notes, if not as they existed on September 5, 1996, at least as they existed prior to the filing date of the Shi reference. The fact that the invention changed since the demonstration of the original code is not a sufficient reason for failing to supply this evidence. Instead, the fact that the code changed since the original code actually clouds the issue of how much of the invention as filed on August 11, 1997 was actually reduced to practice as of September 5, 1996. The only evidence supplied by Applicant to attempt to clarify the issue are the unclear statements made in 2002 regarding a demonstration made 6 years earlier by Applicant to Mr. Haraldsvik. These are not sufficient to establish reduction to practice prior to the filing date of the Shi reference.

d. The two affidavits combined with the non-disclosure agreement, which constitute all of the evidence supplied by Applicant, do not map to the invention as *claimed*, and thus do not establish reduction to practice of the invention as claimed. Note that all of the independent claims cite "delivering information across a computer network," and require a "provider-selected message." Furthermore, claims 2-4, 8, 10, and 11 describe a "server." The affidavits and the non-disclosure agreement all fail to mention the use or demonstration of a computer network, or a provider-selected message, or a server in the original code of the invention. In fact, the affidavit submitted by Mr. Haraldsvik explicitly states that the demonstration was given "using a stand-alone laptop computer without Internet access." See paragraph 4. Thus, the statements as submitted, even if they were supported with additional corroborating evidence would not be sufficient to show that the *claimed* invention was reduced to practice on the date of September 5, 1996.

For these reasons, the Affidavits filed under 37 CFR 1.131 are not sufficient to establish priority over the Shi reference, and the claims are rejected for the reasons stated below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2153

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Shi et al. (U.S. Patent No. 5,875,296, hereinafter "Shi").

In considering claim 1, Shi discloses a method of delivering information across a computer network, comprising the steps of:

Receiving a request from a client program for user-selected information (col. 8, lines 16-18, wherein a server receives an HTTP request from a client browser); and

Transmitting provider-selected information ("login HTML form") in response to the request if no qualifying provider-selected message ("cookie," col. 6, lines 54-55) has been previously transmitted to the client program (col. 8, lines 26-33, wherein if no "cookie" has been transmitted from the provider to the client, then the provider transmits provider-selected login HTML form to the client).

In considering claim 2, claim 2 presents an apparatus for performing the same method as described in claim 1, wherein a server performs the receiving and transmitting steps. Shi discloses this server ("server"), and thus, claim 2 is rejected for the same reasons as claim 1.

In considering claim 3, Shi discloses a method of delivering information across a computer network, comprising the steps of:

Receiving a request from a client program for user-selected information (col. 8, lines 16-18, wherein a server receives an HTTP request from a client browser); and

Transmitting provider-selected information ("login HTML form") in response to the request if no qualifying provider-selected message ("cookie," col. 6, lines 54-55) has been transmitted to the client program within at least one provider-selected interval (col. 8, lines 26-33; col. 9, lines 3-8; col. 7, lines 16-20, wherein if no updated "cookie" has been transmitted from the provider to the client before the provider-selected expiration date of the previous cookie, then the previous cookie is expired, and the provider transmits a provider-selected login HTML form to the client).

In considering claim 4, claim 4 presents an apparatus for performing the same method as described in claim 3, wherein a server performs the receiving and transmitting steps. Shi discloses this server ("server"), and thus, claim 4 is rejected for the same reasons as claim 3.

In considering claim 5, Shi further discloses that the request from the client program is by means of the HTTP ("HTTP request," col. 8, line 16).

In considering claim 6, Shi further discloses transmitting the user-selected information if a qualifying provider-selected message has been previously transmitted to the client program (col. 9, lines 3-8, wherein if a cookie has already been transmitted to the client program, it is used to retrieve the Web document requested).

In considering claim 7, Shi discloses a method of delivering information across a computer network, comprising the steps of:

Receiving a request from a client program for user-selected information (col. 8, lines 16-18, wherein a server receives an HTTP request from a client browser); and

Transmitting provider-selected information ("login HTML form") in response to the request if no qualifying provider-selected message ("cookie," col. 6, lines 54-55) has been previously transmitted to the client program (col. 8, lines 26-33, wherein if no "cookie" has been transmitted from the provider to the client, then the provider transmits provider-selected login HTML form to the client);

The provider-selected information causing the client program to transmit a second request for user-selected information (col. 8, line 32 – col. 9, line 7, wherein the transmission of the login form to the client causes the client browser to later submit the filled in form, which, after authentication is complete, serves as the second request for the data).

In considering claim 8, claim 8 presents an apparatus for performing the same method as described in claim 7, wherein a server performs the receiving and transmitting steps. Shi discloses this server ("server"), and thus, claim 8 is rejected for the same reasons as claim 7.

In considering claim 9, Shi further discloses transmitting the requested user-selected information in response to the second request for user-selected information (col. 9, lines 3-8).

In considering claim 10, Shi discloses a method for delivering information across a computer network comprising the steps of:

Receiving an HTTP GET request from a client program for user-selected information (col. 8, lines 16-17);

Transmitting from a server a provider-selected information ("login HTML form") in response to the HTTP GET request (col. 8, lines 32-33);

The provider-selected message causing the client program to transmit an HTTP POST request (i.e. the form on the browser is filled out and transmitted back to the server); and

Transmitting the user-selected information in response to the HTTP POST request (col. 8, line 34 – col. 9, line 8, wherein the information is sent to the client after the authentication procedure is complete).

In considering claim 11, Shi further discloses that the HTTP POST request includes a referrer header containing a URL for the server (col. 8, lines 33-46, wherein the POST request is sent to the server, and therefore contains its URL).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is 703-306-3041. The examiner can normally be reached from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



BE
September 7, 2004